



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|-----------------------|---------------------|------------------|
| 09/650,045 | 08/29/2000 | William T. Geddes Jr. | 3503-0103P | 8375 |

30593 7590 08/25/2004

HARNESS, DICKEY & PIERCE, P.L.C.

P.O. BOX 8910

RESTON, VA 20195

EXAMINER

THEIN, MARIA TERESA T

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/650,045

Applicant(s)

GEDDES JR. ET AL.

Examiner

Marissa Thein

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 75-85,92-101,114-119,122-133,139 and 151-230 is/are pending in the application.
- 4a) Of the above claim(s) 1-74,86-91,101-113,120,121,134-138 and 140-150 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 75-85,92-101,114-119,122-133,139 and 151-230 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1-11-02; 4-27-04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Applicants "Amendment" filed on April 16, 2004 has been considered with the following effect.

Applicants' response to the Information Disclosure statement, Examiner draws Applicants attention to the Office Action below.

Applicants' response by virtue of amendment to claims 75-76, 78-81, 83-85, 93-95, and 98-100 has not overcome the Examiner's rejection of such claim under 35 USC §101. See discussion below.

Applicants' response to claims 75, 79, 81, 83-84, 95, 97, and 100 has overcome the Examiner's rejection of such claims under 35 USC 112, second paragraph.

Examiner acknowledges the rejoinder of claims 114-119, 122-133, 139, and 151-154.

Claims 75, 77, 114, 118, 125, 127-128, 130, 151-154 have been amended. New claims 155-230 have been added. Claims 1-74, 86-91, 101-113, 120-121, 134-138, and 140-150 have been canceled. Claims 75-85, 92-101, 114-119, 122-133, 139 and claim 151-230 are pending in this application and an action on the merits of these claims follows.

Response to Arguments

Applicant's arguments with respect to claims 75-85, 92-101, 114-119, 122-133, 139, and 151-230 have been considered but are moot in view of the new ground(s) of rejection.

Art Unit: 3625

Information Disclosure Statement

The information disclosure statements filed January 11, 2002 fail to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

The "original PTO-1449" form filed on January 11, 2004 was not considered because there were no legible copies of each publication listed on the form.

The "resubmitting of PTO-1449" (submitted on April 27, 2004) form filed on January 11, 2004 does not list the same references as the original January 11, 2004. The resubmission of PTO-1449 will not be considered. The resubmission, therefore, constitutes as a new submission. The new submission is not in compliance with 37 CFR 1.97(b).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 75-81, 83-85, 114-119, 122-125, 130-133, 151-160, 161-170, 172-177, 180-189, 191-193, 204-208, 217-218, 221-224, and 227-228 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The method claims as presented do not claim a technological basis in the body of the claim. Without a claimed basis, the claim may be interpreted in an alternative as involving no more than a manipulation of an abstract idea and therefore non-statutory

Art Unit: 3625

under 35 U.S.C. 101. For example in claim 75, the body of the claim is a trivial use of the technology. The “notification of a business transaction” is received “via a network connection”, however the method of “determining a business transaction” and the “allocating” are not in the technological arts. There is no structural or functional interrelationship with these method steps. Therefore, the claim is nothing more than an abstract idea, which is not tied to any technological art and is not a useful art. *Ex parte Bowman*, 61 USPQ2d 1665, 1671 (BD, Pats. App. & Inter. 2001). See MPEP 2106 IV 2(b).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 75-85, 92-101, 114-119, 122-125, 129-133, 139, 151-177, 180-206, 209-210, 213-214, 217-218, 221-224, 227-228 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,112,191 to Burke.

Regarding claim 75, Burke discloses a method comprising:

- determining a business transaction proceeds allocation between a plurality of entities (see at least Figure 2; col. 3, lines 4-30; col. 4, lines 11-29; col. 5, lines 5-40);

Art Unit: 3625

- allocating, upon receiving notification of a business transaction, a determined portion of the business transaction proceeds to a first of the plurality of entities and allocating a determined portion to at least one additional entity (see at least col. 5, lines 5-40; Figure 2; col. 6, lines 23-31).

Regarding claim 76, Burke discloses the notification is received from one of the plurality of entities (see at least col. 3, lines 4-30; col. 5, lines 49-51; col. 6, lines 23-31).

Regarding claim 77, Burke disclose the method comprising:

- determining a business transaction proceeds allocation between a plurality of entities (see at least Figure 2; col. 3, lines 4-30; col. 4, lines 11-29; col. 5, lines 5-40); and
- allocating, upon receiving notification of a business transaction, a determined portion of the business transaction proceeds to a first of the plurality of entities and allocating a determined portion to at least one additional entity, wherein the business transaction proceeds allocation is stored in memory (see at least col. 5, lines 5-40; Figure 2; col. 6, lines 23-31; col. 6, lines 46-52).

Regarding claims 78-80, 82-85, 93-96, and 98-101, Burke the business transaction proceeds allocation includes a fixed fee per transaction for at least one entity (see at least col. 6, lines 23-32; col. 7, line 63 – col. 8, line 9); the business transaction proceeds allocation includes a predetermined percentage allocation for at least one entity (see at least col. 12, lines 11-24; col. 12, lines 50-59); and sending the allocated determined portions of the business transaction proceeds to each of the first

Art Unit: 3625

and at least one additional entity (see at least col. 6, lines 23-32; col. 7, line 63 – col. 8, line 9).

Regarding claims 81 and 97, Burke discloses receive a fund distribution request based upon a business transaction (see at least Figure 2; col. 3, lines 4-30; col. 4, lines 11-29; col. 5, lines 5-40; col. 11, lines 24-30; col. 12, lines 11-24); and determination whether or not the fund distribution request is subject to a predetermined business transaction proceeds allocation, wherein the business transaction proceeds allocation is determine upon first determining that the fund distribution request is subject to a predetermined business transaction proceeds allocation (see at least col. 11, lines 24-30; col. 11, lines 47-67; col. 12, lines 11-24; col. 12, lines 50-59).

Regarding claim 92, Burke discloses a system comprising:

- a database, adapted to store at least one business transaction proceeds allocation between plurality of entities (see at least Figure 2; col. 3, lines 4-30; col. 4, lines 11-29; col. 5, lines 5-40);
- a controller, adapted to determine a business transaction proceeds allocation between a plurality of entities from the data base, and adopted to, upon receiving notification, allocate a determined portion of the business transaction proceeds to a first of the plurality of entities and allocate a determined portion to at least one additional entity (see at least col. 5, lines 5-40; Figure 2; col. 6, lines 23-31; col. 6, lines 46-52).

Regarding claim 114, Burke discloses a method further comprising:

Art Unit: 3625

- associating a user of a computer device with at least one of a plurality of beneficiary group (see at least col. 4, lines 54-55; col. 5, lines 21-27; col. 6, lines 23-32; col. 9, line 64 – col. 10, line 23); and
- providing an arrangement for transacting business, associating the user with at least one provider of a good, service, or information, the at least one provider being one of the plurality of entities and being associated with at least one beneficiary group including at least one beneficiary group associated with the user, wherein at least one additional entity includes at least one of the plurality of beneficiary groups associated with the user (see at least col. 3, lines 4-30; col. 4, lines 11-29; col. 5, lines 5-40; Figure 2; col. 6, lines 23-31; col. 6, lines 46-52).

Regarding claims 115-119 and 122-123, Burke discloses arranging for the at least one beneficiary group associated with the user to benefit from the user obtaining a good, service or information from the at least one associated provider (see at least col. 4, lines 54-55; col. 5, lines 21-27; col. 6, lines 23-32; col. 9, line 64 – col. 10, line 23); arranging for at least one associated provider to benefit the at least one beneficiary group associated with the user, upon the user obtaining a good, service or information from at least one associated provider (see at least col. 3, lines 49-64; col. 4, lines 11-29; col. 5, lines 21-40; col. 6, lines 23-32); arranging for the user to obtain the desired good, service or information from at least one associated provider (see at least col. 5, lines 54-62; col. 6, line 53 – col. 7, line 13); wherein at least one of the plurality of beneficiary groups is an entity (see at least col. 7, line 63 – col. 8, line 10; col. 8, lines 54-67); wherein at least one of the plurality of beneficiary groups includes an entity (see at least

Art Unit: 3625

col. 7, line 63 – col. 8, line 10; col. 8, lines 54-67); wherein the arranging includes providing to the user a display including a name of at least one associated provider (see at least col. 3, lines 49-64).

Regarding claims 124-125, Burke discloses the method further comprising:

- receiving an input request and user-specified beneficiary group, associating the user with a beneficiary group, from the computer device of the user (see at least col. 4, lines 54-55; col. 5, lines 21-27; col. 6, lines 23-32; col. 9, line 64 – col. 10, line 23); and
- searching for at least one provider, based upon the arrangement and the received input request and user-specified beneficiary group, the arrangement including a synergistic concentric circle arrangement (see at least col. 4, lines 11-29; col. 6, lines 23-32; col. 7, line 63- col. 8, line 29); and
- outputting any associated providers to the user (see at least col. 4, lines 11-29; col. 6, lines 23-32; col. 7, line 63- col. 8, line 29).

Regarding claim 129, Burke discloses the computer device includes one of a personal computer, personal digital assistant and wireless phone (see at least col. 2, lines 46-60; col. 4, lines 11-20; col. 5, lines 32-40).

Regarding claim 130, Burke discloses:

- receiving from a computer device of a user, a request including a desired good, service or information and at least one user-specified beneficiary group (see at least Figure 2; col. 5, lines 54- col. 6, line 32);

Art Unit: 3625

- associating the user to at least one provider of the requested good, service or information, associated with at least one beneficiary group including the at least one user-specified beneficiary group, for transacting business based upon the received request and at the least one user-specified beneficiary group, wherein the at least one additional entity includes the at least one of the beneficiary groups associated with the users (see at least Figure 2; col. 5, lines 54- col. 6, line 56).

Regarding claims 131-133, the claims are rejected on the same grounds as claims 115-117 above.

Regarding claim 139, the claim is rejected on the same grounds as claim 129 above.

Regarding claims 151-154, Burke discloses wherein the business transaction proceeds allocation to another entity is a predetermined percentage of the business transaction proceeds (see at least col. 12, lines 11-24; col. 12, lines 50-59); and wherein the business transaction proceeds is a predetermined fixed fee (see at least col. 6, lines 23-32; col. 7, line 63 – col. 8, line 9).

Regarding claims 155-160, Burke discloses wherein the first of the plurality of entities includes a provider of at least one of a good, service, or information; wherein one of plurality of entities includes a consumer of at least one of a good, service, or information of the provider; and wherein at least one additional entity does not include the consumer (see at least col. 2, lines 46-59; col. 3, lines 14-35; col. 4, lines 11-28; col. 4, lines 30-62).

Art Unit: 3625

Regarding claim 161, Burke discloses a method comprising:

- receiving notification, via a network connection, of a business transaction between a plurality of entities (see at least Figure 2; col. 3, lines 4-30; col. 4, lines 11-29; col. 5, lines 5-40; col. 5, lines 49-51; col. 6, lines 23-31); and
- allocating a predetermined portion of proceeds of the business transaction to a first of the plurality of entities and allocating a determined portion to at least additional entity (see at least col. 5, lines 5-40; Figure 2; col. 6, lines 23-31; col. 12, lines 11-24; col. 12, lines 50-59).

Regarding claims 162-165, the claims are rejected on the same grounds as claims 155-160 above.

Regarding claims 164-169, the claims are rejected on the same grounds as claims 76 and 78-80 above.

Regarding claim 170, the method further comprising:

- receiving a fund distribution request based upon the business transaction (see at least Figure 2; col. 3, lines 4-30; col. 4, lines 11-29; col. 5, lines 5-40; col. 11, lines 24-30; col. 12, lines 11-24); and
- determining whether or not the fund distribution request is subject to a predetermined business transaction proceeds allocation, wherein the business transaction proceeds allocation is determined only upon first determining that the fund distribution request is subject to a predetermined business transaction proceeds allocation (see at least col. 11, lines 24-30; col. 11, lines 47-67; col. 12, lines 11-24; col. 12, lines 50-59).

Art Unit: 3625

Regarding claims 171-174, the claims are rejected on the same grounds as claims 82-85 above.

Regarding claim 175, the claim is rejected on the same grounds as claim 114 above.

Regarding claim 176, the claim is rejected on the same grounds as claim 119 above.

Regarding claim 177, the claim is rejected on the same grounds as claim 124 above.

Regarding claim 180, Burke discloses the method comprising:

- storing business transaction proceeds allocation information (see at least col. 5, lines 5-40; Figure 2; col. 6, lines 23-31; claim 33); and
- allocating, upon receiving notification of a business transaction between a plurality of entities via network connection, a portion of proceeds of the business transaction to a first of the plurality of entities based upon the stored business transaction proceeds allocation information, and allocating a portion of proceeds of the business transaction to at least one additional entity based upon the stored business transaction proceeds allocation information (see at least col. 5, lines 5-40; Figure 2; col. 6, lines 23-31; col. 12, lines 11-24; col. 12, lines 50-59).

Regarding claims 181-184, the claims are rejected on the same grounds as claims 155-157 above.

Regarding claims 185-188, the claims are rejected on the same grounds as claims 76 and 78-80 above.

Art Unit: 3625

Regarding claim 189, the claim is rejected on the same grounds as claim 81 above.

Regarding claims 190-193, the claims are rejected on the same grounds as claims 82-85 above.

Regarding claim 194, Burke discloses a system comprising:

- a database, adapted to store business transaction proceeds allocation information (see at least col. 5, lines 5-40; Figure 2; col. 6, lines 23-31; claim 33); and
- a controller, adapted to, upon receiving notification of a business transaction between a plurality of entities via a network connection, allocate a portion of proceeds of the business transaction to a first of the plurality of entities based upon the stored business transaction proceeds allocation information and allocate a portion of proceeds of the business transaction to at least one additional entity based upon the stored business transaction proceeds allocation information (see at least Figure 2; col. 3, lines 4-30; col. 4, lines 11-29; col. 5, lines 5-40; col. 11, lines 24-30; col. 11, lines 47-67; col. 12, lines 11-24; col. 12, lines 50-59).

Regarding claims 195-198, the claims are rejected on the same grounds as claims 93-96 above.

Regarding claim 199, the claim is rejected on the same grounds as claim 97 above.

Regarding claims 200-203, the claims are rejected on the same grounds as claims 98-101 above.

Regarding claim 204, the claim is rejected on the same grounds as claim 114 above.

Regarding claim 205, the claim is rejected on the same grounds as claim 119 above.

Regarding claim 206, the claims are rejected on the same grounds as claim 124 above.

Regarding claims 209, Burke discloses a consumer is associated with at least one of a plurality of beneficiary groups, and the at least one provider is one of the plurality of entities and is associated with at least one beneficiary group including the at least one beneficiary group associated with the user, wherein the at least one additional entity includes at least one of the plurality of beneficiary groups associated with the user (see at least col. 2, lines 46-59; col. 3, lines 4-35; col. 4, lines 11-29; col. 4, lines 30-62; col. 5, lines 5-40; Figure 2; col. 6, lines 23-31; col. 6, lines 46-52).

Regarding claims 210, 214, 218, 222, 224 and 228, the claims are rejected on the same grounds as claim 119 above.

Regarding claims 213, 217, 221, 223, and 227, the claims are rejected on the same grounds as claim 209 above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3625

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 126-128, 178-179, 207-208, 211-212, 215-216, 219-220, 225-226, and 229-230 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent No. 6,112,191 to Burke in view of U.S. Patent No. 5,819,092 to Ferguson et al. Burke substantially discloses the claimed invention. However, Burke does not explicitly disclose hyperlinks, Internet connection and worldwide web. Burke discloses a system that can operate in an online mode (col. 9, lines 15-18). Furthermore, Burke discloses a communication system that may include telephone lines, satellites or cables connection and where locations of computers are remote from the central computer (col. 5, lines 7-13). Ferguson, on the other hand, teaches hyperlinks, Internet connection and worldwide web (col. 7, lines 36-46; col. 10, lines 29-39; col. 10, lines 55-61). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method and system of Burke, to include hyperlinks, Internet connection and worldwide web, as taught by Ferguson, in order to provide global communication anywhere in the world.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 3625

U.S. Patent No. 5,466,919 to Hovakimian discloses a method which enables a credit cardholder to make a donation to cardholder-selected charity any time he makes a purchase using the credit card.

U.S. Patent No. 5,621,640 to Burke discloses an automatic donation system for sales establishment includes an entry arrangement for entering the price of a product into a cash register and for determining the excess cash payment.

U.S. Patent No. 5,846,828 to Atkins discloses a personal financial program for implementing, coordinating, supervising, analyzing and reporting inventions in an array of asset accounts and credit facilities within a client account.

U.S. Patent No. 5,884,280 to Yohioka et al. discloses a system which distributes proceeds of a sold content to third parties.

U.S. Patent No. 6,052,674 to Zervides et al. discloses an electronic commerce invoicing and collection system.

U.S. Patent No. 6,581,041 to Canney discloses a method of charitable giving with investing and consumer purchasing.

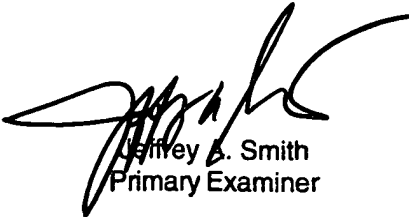
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 703-305-5246. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Smith can be reached on 703-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mtot
August 22, 2004



Jeffrey A. Smith
Primary Examiner